

REMARKS

The Official Action dated October 3, 2001 has been carefully considered.

Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

By present amendment, the Abstract of the Disclosure has been amended to remove the language objected to by the Examiner. Claims 1 and 7 were amended to more clearly define the invention. Support for these amendments may be found at page 3 of the specification. Finally, attached hereto is a **"Versions With Markings to Show Changes Made"** showing the changes made to the Abstract and claims by the current amendment. Since these changes are believed to be fully supported by the specification and claims as originally filed and no new matter is intended or believed to be involved, entry is believed to be in order and is respectfully requested.

I. Rejections Under 35 U.S.C. §102

In the Official Action, claims 1, 2 and 6-12 were rejected under 35 U.S.C. §102(e) as being anticipated by Stephenson (U.S. Patent No. 5,949,469). The Examiner asserts that Stephenson teaches a printer configuration comprising a digital camera comprising a viewable display and one or more selection mechanisms, and a photoprinter connected to the digital camera via a communication link. The Examiner further asserted that Stephenson discloses that the photoprinter is operative to control the viewable display of the digital camera. The Examiner further referred to figure 3 of the Stephenson patent.

However, as will be set forth in detail below, it is submitted that the photoprinter configurations and method for controlling a digital camera defined by claims 1, 2 and 6-12 are

not anticipated by Stephenson. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, the present invention is directed to a photoprinter configuration. The configuration comprises a) a digital camera comprising a viewable display and one or more selection mechanisms; and b) a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera.

As defined by claim 7, the present invention is directed towards a method for controlling a digital camera. The method comprises a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media; b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms; c) connecting the digital camera to the photoprinter via a communication link; d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.

Stephenson discloses an apparatus for printing images from a liquid crystal display included within an image capture device including a liquid crystal display; a source of fluorescent light which includes phosphors; and a printer which includes photosensitive media which is adapted to be illuminated by the light image from the liquid crystal display.

In the Official Action, the Examiner has asserted that the apparatus for printing images shown in FIG. 3 is a photoprinter. However, Applicants find no teaching, suggestion or disclosure in Stephenson relating to the printer configurations and methods for controlling a digital camera defined by claims 1, 2 and 6-12. Although Stephenson discloses mounting a printer 12 onto an electronic camera 10 having a camera display 18 for displaying an

electronically stored image, one skilled in the art will recognize that this configuration is not a photoprinter as required by claims 1, 2 and 6-12. As defined by the present invention, a photoprinter is a stand-alone appliance for printing digital photographs onto a printable medium (see p. 3, lines 13 and 4 of the present specification). Moreover, the term "stand-alone" is defined as a printer capable of processing and printing digital files independent of an external host device, wherein processing means calculating a pixel pattern to be printed on the printable medium that represents the corresponding digital file. (see p. 3, lines 17-20 of the present specification). To the contrary, the printer of Stephenson uses light emitted from the liquid crystal display of the camera to write to photosensitive media.

Anticipation under 35 U.S.C. §102 requires the disclosure in a single prior art reference of each element of the claims under consideration, *Alco Standard Corp. v. TVA*, 808 F.2d 1490, 1 U.S.P.Q.2d 1337 (1341) (Fed. Cir. 1986). As Applicants find no teaching by Stephenson relating to photoprinter configurations comprising a stand-alone appliance capable of processing and printing digital files independent of an external host device as required by claims 1, 2 and 6 or methods for controlling a digital camera having a stand-alone appliance for printing digital photographs onto a printable medium as required by claims 7-12, Stephenson does not anticipate claims 1, 2 and 6-12 under 35 U.S.C. §102.

It is therefore submitted that the presently claimed printer configurations and methods are not anticipated by Stephenson, whereby the rejection under 35 U.S.C. §102 (e) has been overcome. Reconsideration is respectfully requested.

II. Rejections Under 35 U.S.C. §103

In the Official Action, claims 3 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stephenson as applied to claim 1 above. With respect to claim 3, the Examiner noted that Stephenson does not teach the communication link comprising a universal serial bus.

The Examiner asserted that it is well known in the art of photo printing to use a universal serial bus between a photoprinter and a digital camera. The Examiner concluded that it would have been obvious to a person with ordinary skill in the art to have modified Stephenson to include a universal serial bus as a communication link. With respect to claim 5, the Examiner noted that Stephenson fails to teach using an open operating system. The Examiner asserted that it is well known in the art of digital cameras to use an open operating system. The Examiner concluded that it would have been obvious to a person with ordinary skill in the art to have modified Stephenson to include an open operating system.

However, as will be set forth in detail below, it is submitted that the photoprinter configurations of claims 3 and 5 are non-obvious and patentably distinguishable from the teachings of Stephenson. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 3, the present invention is directed towards a photoprinter configuration of claim 1, further comprising the communications link being a universal serial bus. As defined by claim 5, the present invention is directed towards a photoprinter configuration of claim 1, further comprising the digital camera being an open operating system.

As noted above, Stephenson fails to teach or suggest a photoprinter configuration comprising, inter alia, a stand-alone appliance capable of processing and printing digital files independent of an external host device as required by independent claim 1.

References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public. *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Applicants find no teaching or suggestion by Stephenson of a stand-alone photoprinter. As defined by the present specification, a photoprinter

is a stand-alone appliance for printing digital photographs onto a printable medium (see p.3, lines 13 and 14).

Furthermore, to establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974). In view of the failure of Stephenson to teach, disclose or suggest a stand-alone photoprinter, Stephenson does not render the presently claimed printer configuration obvious. It is therefore submitted that the presently claimed printer configuration is non-obvious over and patentably distinguishable from Stephenson, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious, *In re Fine*, 837 F.2d 1071; 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). As claims 3 and 5 depend from and incorporate all of the limitations of claim 1, it is respectfully submitted that claims 3 and 5 are nonobvious over and patentably distinct from Stephenson, whereby the rejection under 35 U.S.C. §103(a) has been overcome. Reconsideration is respectfully requested.

In the Official Action, claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Stephenson as applied to claim 1 above, and further in view of Hanada (U.S. Patent No. 6,000,864). The Examiner noted that Stephenson does not teach using a wireless communication link. The Examiner relied on Hanada as teaching that it is well known to transmit data between a digital camera and a printer using wireless means. The Examiner concluded that it would have been obvious to a person of ordinary skill in the art to provide the apparatus of Stephenson with means to transmit data wirelessly.

However, as will be set forth in detail below, it is submitted that the photoprinter configuration of claim 4 is non-obvious and patently distinguishable from the teachings of Stephenson in further view of Hanada.

As defined by claim 4, the present invention is directed towards a photoprinter configuration of claim 1, further comprising the communications link being wireless.

As noted above, Stephenson fails to teach or suggest a photoprinter configuration comprising, inter alia, a stand-alone appliance capable of processing and printing digital files independent of an external host device as required by independent claim 1. Furthermore, the deficiencies of Stephenson as discussed above with respect to independent claim 1, are not resolved by Hanada. That is, despite Hanada's teaching of transmitting print data between a digital camera and a printer via wireless communication, Applicants find no teaching or suggestion by Hanada of a photoprinter configuration comprising, inter alia, a stand-alone photoprinter capable of processing and printing digital files independent of an external host device.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, supra. In view of the failure of Stephenson and Hanada, alone or in combination, to teach, disclose or suggest photoprinter configurations comprising, inter alia, a stand-alone photoprinter, the combination of Stephenson and Hanada does not support a rejection under 35 U.S.C. §103.

It is therefore submitted that the presently claimed photoprinter configuration is non-obvious over and patentably distinguishable from Stephenson in view of Hanada, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Claims 13-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Stephenson as applied to claims 1-6, in further view of Taniguchi et al (U.S. Patent No.

5,999,707). The Examiner noted that Stephenson does not teach or suggest a printer as being operable as a client to a host computer. The Examiner relied on Taniguchi et al as teaching printers that operate as a client to a host computer. The Examiner concluded that it would have been obvious to a person with ordinary skill in the art to provide the system taught by Stephenson with a host and allowing the printer to operate as a host to the printer.

However, as will be set forth in detail below, it is submitted that the printer configurations of claims 13-23 are non-obvious and patentably distinguishable from the teachings of Stephenson in further view of Taniguchi et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 13, the present invention is directed to a printer configuration. The configuration comprises a) a host computer, b) a peripheral device and c) a stand-alone printer connected via a communication link to the host computer and peripheral device, wherein the stand-alone printer is operable as a client to the host computer, as a host for the peripheral device, and as a passthrough device such that the host computer may initiate requests to the peripheral device.

As defined by claim 21, the present invention is directed to a printer configuration. The configuration comprises a) a universal serial bus, b) a stand-alone printer connected to the universal serial bus as a universal serial bus host, and c) a peripheral device connected to the universal serial bus as a universal serial bus device. The peripheral device is subordinate to the stand-alone printer.

As set forth in MPEP § 2143, the three basic requirements of a prima facie case of obviousness are: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings; 2) there must be a reasonable expectation of

success; and 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. Moreover, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As discussed above, Stephenson fails to teach or suggest a printer configuration comprising, inter alia, a stand-alone printer capable of processing and printing digital files independent of an external host device. Assuming, in arguendo, that the cited prior art can be combined, such a combination would still not disclose all of the limitations of the Applicants' claimed invention as set forth in claims 13-23. In particular, despite Taniguchi et al's teaching that a printer can operate as a client to a host computer, Applicants find no teaching or suggestion by Taniguchi et al of a printer configuration comprising, inter alia, a stand-alone printer capable of processing and printing digital files independent of an external host device.

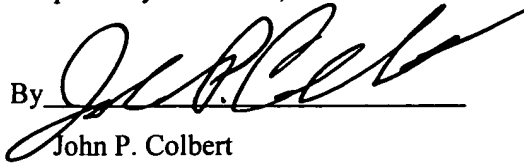
To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, supra. In view of the failure of Stephenson and Taniguchi et al, alone or in combination, to teach, disclose or suggest printer configurations comprising, inter alia, a stand-alone printer, the combination of Stephenson and Taniguchi et al do not support a rejection under 35 U.S.C. §103.

It is therefore submitted that the presently claimed printer configuration is non-obvious over and patentably distinguishable from Stephenson in view of Taniguchi et al, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the Examiner's objections and rejections under 35 U.S.C. §§102 and 103 and places the present application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read "John P. Colbert", is written over a horizontal line.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Abstract:

The Abstract of the Disclosure following the claims has been amended as follows:

ABSTRACT OF THE DISCLOSURE

A photoprinter configuration including a digital camera [comprising] having a viewable display and one or more selection mechanisms. A photoprinter is connected to the digital camera via a communication link, wherein the photoprinter is operative to control the viewable display of the digital camera. Preferably, the photoprinter is further operative to direct the results from a user's inputs to the selection mechanisms of the digital camera. The photoprinter is operable as a client to a host computer, as a host for the digital camera, and a passthrough device such that the host computer may initiate requests to the digital camera.

In the claims:

1. (Amended) A photoprinter configuration, comprising:
 - a) a digital camera comprising a viewable display and one or more selection mechanisms;
 - and
 - b) a photoprinter capable of processing and printing digital files independent of an external host device and connected to the digital camera via a communication link, the photoprinter being operative to control the viewable display of the digital camera.

7. (Amended) A method for controlling a digital camera, comprising the steps of:

a) obtaining a photoprinter capable of processing and printing digital files independent of an external host device and operative to print digital photographs onto printable media;

b) obtaining a digital camera comprising a viewable display and one or more selection mechanisms;

c) connecting the digital camera to the photoprinter via a communication link; [and]

d) transmitting a plurality of instructions from the photoprinter to the digital camera via the communication link; and

e) controlling the digital camera by the photoprinter in accordance with the plurality of instructions.